Supreme Court, U.S.
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No. 99-2068

IN THE

Supreme Court of the United States

COLLECTIBLES, INC., d/b/a Collectables Records

Petitioner,

vs.

LEONARD BROWN; WALTER PRICE; PETE MAYES; JAMES NELSON; JOE HUGHES, a/k/a Joe "Guitar" Hughes; RAYFIELD JACKSON, a/k/a "Houston Guitar Slim"; FREDDIE COLLINS, a/k/a "Big Roger" Collins; FALIETA GREEN as Independent Executrix of the Estate of Clarence Green; THOMAS DARDAR, a/k/a Tommy Dardar; ROBBYE R. WALDRON for the Estate of Alfred R. Bettis a/k/a "Big Al" Bettis; DEBRA L. NICKERSON as heir to the Estate of Weldon Bonner a/k/a "Juke Boy Bonner"; LIZETTE COBB as heir to the Estate of Arnett Cobb; and KINNEY ABAIR

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

PETITIONER'S REPLY MEMORANDUM

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THE MUSICIANS' BRIEF IN OPPOSITION FURTHER SUPPORTS THE GRANTING OF COLLECTIBLES' PETITION

Respondents' Brief in Opposition to the Petition for Writ of Certiorari of Collectibles, Inc. is long on vitriol and short on reasons for denying the writ. Indeed, the respondent musicians' Brief highlights the dangers to the uniform federal system of rights and remedies promulgated by the Copyright Act, as well as the confusion that exists in the absence of any pronouncement by this Court on the scope of preemption after the 1978 enactment of Section 301(a) of the Copyright Act.

A. The musicians misconstrue the right of publicity tort.

Initially, the musicians misapprehend the rights protected by the state common law tort of misappropriation of name and likeness. As even the Fifth Circuit has noted, "[t]he misappropriation tort does not protect one's name *per se* . . ." but rather the commercial value associated with one's name or likeness. *Matthews v. Wozencraft*, 15 F.3d 432, 437 (5th Cir. 1994); *see also Rogers v. Grimaldi*, 875 F.3d 994, 1003 (2d Cir.

1989). In fixing a work in a tangible medium of expression, and claiming copyright protection for that work, an author or creator seeks to be associated with that work and to benefit commercially from such association with that work. *See, e.g., Mazer v. Stein*, 347 U.S. 201, 219 (1954) ("The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors. . . .").[1]

The association of a performer's name or "persona" with his own copyrightable performance enhances rather than diminishes the commercial value of his name and his "persona." To allow such a benefit to inure to an author under the Copyright Act, while still imposing additional liability for misappropriation

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[1]In fact, Collectibles, pursuant to its licensing agreements with producer Roy C. Ames, paid all royalties due and owing on the sales of the CD's and cassettes at issue to Ames. The evidence at trial showed that Ames in turn paid or credited royalties to the musicians. *See Allison v. Vintage Sport Plaques*, 136 F.3d 1443, 1449 (11th Cir. 1998) (noting that despite the preemptive effect of the first sale doctrine of the Copyright Act on the right of publicity, the celebrities at issue still received royalties from the first sale of the property at issue).

under the particular common laws of the fifty states for associating the "persona" of the author with his own work, is inconsistent with the fundamental philosophy of the Copyright Act and further defeats the express preemptive intent of the Act.[2]

B. The musicians recognize the consequences of the Fifth Circuit's holding below.

The musicians assert that the Fifth Circuit opinion does not have "far reaching implications." *See* Respondents' Brief at p. 4. However, immediately before this assertion, the musicians acknowledge that any publisher, such as Collectibles, that uses the names and likenesses of the author of a tangible work in connection with the sale of that tangible work should be liable under the laws of "Texas, California and New York," not to

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[2]The proposition that an author of a work fixed in a tangible medium of expression, especially one who attempts to register for copyright protection, wants not only his name but also his "persona" associated with that work is underscored here. Contrary to the musicians ill-considered attempt to rephrase the question presented, every copyright claimed by the musicians included the name of the musician, and the claimed copyrights in sound recordings would necessarily include the "likeness" (i.e. the voice) of the musician. Moreover, many of the deposit copies for which the musicians claimed copyright consisted of the actual Collectibles CD's, which not only bore the complained of names and likenesses (i.e. voices) of the musicians but sometimes their images as well.

mention the other fifty states (*See* Respondent's Brief at p. 3). Thus, the musicians acknowledge the threat to the uniform federal system Congress envisioned for works fixed in a tangible medium of expression.

The musicians cite the legislative history of § 114 of the Copyright Act for the proposition that certain species of the "evolving common law rights of privacy, publicity and trade secrets" remain unaffected by the preemption provision of the Act. H.R. Rep. No. 1476. 94th Cong. 2d Sess. 201 (1976) *reprinted following* 17 U.S.C.A. § 301 at 377. The musicians apparently claim that the right of publicity has developed to such an extent that it allows authors of works fixed in a tangible medium of expression to assert causes of action based on the misappropriation laws of the fifty states, rather than the Copyright Act, for the unauthorized use of their own fixed, tangible works as long as those works include their names or likenesses. This argument only supports the granting of

Collectibles' Petition in order to consider whether such common law rights have evolved, or can evolve, to such a degree.

C. <u>There exists an irreconcilable conflict between the circuits.</u>

The musicians in their Brief attempt to minimize the patent conflict between the Fifth Circuit, on the one hand, and the Seventh and Eleventh Circuits, on the other, by contending that *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663 (7th Cir. 1986), *cert. denied*, 480 U.S. 941 (1987) and *Allison v. Vintage Sports Players* stand for the proposition that a right of publicity claim may be preempted only when the likeness of the individual asserting such a claim appears in the copyrighted work. This attempted distinction is unsupported. Indeed, *Baltimore Orioles* is much broader than as characterized by the musicians and specifically addresses the preemption issue when a "performance," like the musicians' performances in this case, is fixed in a tangible form. "Because a performance is fixed in tangible form when it is recorded, a right of publicity in a

performance that has been reduced to tangible form is subject to preemption." 805 F.2d at 678 n.26.

To further illustrate the direct conflict between the circuits, the Fifth Circuit in its opinion below cited this Court's holding in *Zachini v Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977). Yet the Seventh Circuit expressly stated in *Baltimore Orioles* that had *Zachini* been decided after § 301(a) of the Copyright Act became effective in 1978, and had Hugo Zachini caused his human cannonball act to be recorded (i.e. fixed in a tangible medium of expression) -- two factors that are present in the instant case[3] -- the *Zachini* case would have been decided differently. 805 F.2d at 675 n.22.

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[3]Oddly, the musicians at one point, in their zeal to use pejorative terms, label the recordings "counterfeit" (Respondent's Brief at p. 2), though at another point in their Brief they inconsistently refer to the recordings as "stolen." (Respondent's Brief at p. 1). The fact remains, however, that the musicians themselves claimed a copyright on each and every one of the musical works at issue and there was no finding by the jury, nor was there even a request for one, that the recordings were "counterfeit." Moreover, there was no question that the musicians themselves were responsible for, and participated in, their performances becoming "fixed."

D. **The musicians' erroneous factual assertions**

Finally, the musicians' factual assertions in their Brief are, for the most part, as irrelevant as they are erroneous and unsupported by the record. Thus, Collectibles need not address each and every such statement. However, the musicians citation of, and discussion of, *King v. Ames*, 179 F.3d 370 (5th Cir. 1999) is particularly fallacious. As may be inferred from the musicians' barbed discussion of that case, Collectibles was awarded a take nothing judgment in the trial court and was awarded its costs. As the Fifth Circuit opinion makes clear, King did not pursue an appeal against Collectibles. 179 F.3d at 372 n.2. Most importantly, the *King v. Ames* opinion does not address, discuss or in any way decide the preemption issue presented herein. The assertion that Collectibles "lost" anything in that case, or that the case is somehow relevant to the Court's consideration of Collectibles' Petition herein, is entirely unfounded.

CONCLUSION

The musicians' contentions regarding Collectibles' susceptibility to state law misappropriation claims in the fifty states for reproduction of sound recordings bearing the name and likeness of the recording artist or composer, and the musicians' contentions regarding how far such misappropriation claims have "evolved" since 1978, only highlight the reasons why this case merits the Court's full consideration.

Respectfully submitted,

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